

2. REMARKS / DISCUSSION OF ISSUES

Claims 1-6 are pending in the application. Claims 1 and 6 are the independent claims.

Rejections under 35 U.S.C. § 103

Applicants gratefully acknowledge the withdrawal of the rejection under 35 U.S.C. § 102(b) in view of *Thornton, et al.* However, Applicants have reviewed the rejection of claims 1-6 in view of *Thornton, et al.* and *Kitamura, et al.* (U.S. Patent 5,986,996) under 35 U.S.C. § 103 and respectfully submit that this rejection is improper and should be withdrawn.

A *prima facie* case of obviousness has three requirements. First, the prior art relied upon, coupled with the knowledge generally available in the art at the time of the invention, requires some reason that the skilled artisan would modify a reference or to combine references.¹ The Supreme Court has, however, cautioned against the use of “rigid and mandatory formulas” particularly with regards to finding reasons prompting a person of ordinary skill in the art to combine elements in the way the claimed new invention does.² But rather the Supreme Court suggests a broad, flexible “functional approach” to the obviousness analysis recognizing that “[i]n many fields it may be that there is little discussion of obvious techniques or combinations.”³ Second, the proposed modification of the prior art must have had a reasonable expectation of success, determined from the vantage point of the skilled artisan at the same time the invention was made. In other words, a hindsight analysis is not allowed.⁴ Lastly, the prior art

¹ See *Princeton Biochemicals, Inc. v. Beckman Coulter, Inc.*, 411 F.3d 1332 (Fed. Cir. 2005) (“[S]imply identifying all of the elements in a claim in the prior art does not render a claim obvious.”).

² See *KSR Int’l Co. v. Teleflex Inc.*, 127 S. Ct. 1727 (2007) (“The obviousness analysis cannot be confined by a formalistic conception of the words teaching, suggestion, and motivation, or by overemphasis on the importance of published articles and the explicit content of issued patents.”).

³ *Id.* See also *Id.* at 1743 F.3d 1356 (Fed. Cir. 2006) (“Our suggestion test is in actuality quite flexible and not only permits, but *requires*, consideration of common knowledge and common sense”) (emphasis in original).

⁴ See *Amgen, Inc. v. Chugai Pharm. Co.*, 927 F.2d 1200 (Fed. Cir. 1991) (“Hindsight is not a justifiable basis on which to find that ultimate achievement of a long sought and difficult scientific goal

reference or combination of references must teach or suggest all the limitations of the claims.⁵

a. Claims 1 and 6

Claim 1 recites:

An arrangement for read-out of information from an optical information carrier, comprising:

a light source configured to illuminate said information carrier;

an optical system configured to receive light reflected from the information carrier and to inject the reflected light into a vertical-cavity surface-emitting laser (VCSEL), said VCSEL having a front side for receiving said reflected light and a rear opposite said front side, wherein the VCSEL is configured to emit light through its rear;

a photodetector is provided adjacent said rear to detect light emitted through the rear of the VCSEL; and

a polarizer arranged between said rear of the VCSEL and said photodetector.

Claim 6 is directed to a method and includes features similar to those of claim 1 discussed below.

The Office Action concedes that *Thornton, et al.* does not disclose a polarizer arranged between the rear of the VCSEL and a photodetector, and directs Applicants to *Kitamura, et al.* for the alleged disclosure of this feature of claim 1.

At the outset, that *Kitamura, et al.* comprises 40 columns of specification and claims and 15 drawing sheets. However, Applicants are generally directed to columns 7 of *Kitamura, et al.* not specifically directed to any particular reference characters or features of *Kitamura, et al.* for the alleged disclosure of the polarizer disposed between the rear of a VCSEL and a photodetector as specifically recited in claim 1. Applicants

was obvious.”).

⁵ See In re Wilson, 424 F.2d 1382 (C.C.P.A. 1970) (“All words in a claim must be considered in judging the patentability of that claim against the prior art.”).

therefore respectfully submit that the rejection fails to comply with MPEP § 706, which states, in part:

The goal of examination is to clearly articulate any rejection early in the prosecution process so that the applicant has the opportunity to provide evidence of patentability and otherwise reply completely at the earliest opportunity (emphasis added).

The rejection likewise fails to comply with 37 CFR § 1.104(c)(2), which provides:

In rejecting claims for want of novelty or for obviousness, the examiner must cite the best references at his or her command. When a reference is complex or shows or describes inventions other than that claimed by the applicant, the particular part relied on must be designated as nearly as practicable. The pertinence of each reference, if not apparent, must be clearly explained and each rejected claim specified (emphasis added).

The above notwithstanding, Applicants respectfully submit that while a polarizer (9) is shown in Fig. 1, this polarizer is disposed between a surface emitting laser (3) and an optical disc 1a. Fig. 7 does disclose detector arrays 4a in Figs. 1 and 7, for example, but these are adjacent to the surface emitting laser 3 and there is no disclosure of a polarizer's being disposed between a rear of the a VCSEL and a photodetector as specifically recited in claim 1. (Kindly refer to Figs. 1 and 7 and their supporting descriptions in *Kitamura, et al.*)

Accordingly, while Applicants in no way concede the propriety of the combination of references, for at least the reasons set forth above, Applicants respectfully

submit that the combination of *Thorton, et al.* and *Kitamura, et al.* fails to disclose at least one feature of each of claims 1 and 6. Therefore, a *prima facie* case of obviousness has not been established and claims 1 and 6 are patentable over the applied art. Moreover, Applicants respectfully submit that claims 2-5, which depend from claim 1, are patentable for at least the same reasons and in view of their additionally recited subject matter.

Conclusion

In view of the foregoing, applicant(s) respectfully request(s) that the Examiner withdraw the objection(s) and/or rejection(s) of record, allow all the pending claims, and find the application in condition for allowance.

If any points remain in issue that may best be resolved through a personal or telephonic interview, the Examiner is respectfully requested to contact the undersigned at the telephone number listed below.

Respectfully submitted on behalf of:
Phillips Electronics North America Corp.

/William S. Francos/

by: William S. Francos (Reg. No. 38,456)

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Valentine & Whitt, PLLC
Two Meridian Blvd.
Wyomissing, PA 19610
(610) 375-3513 (v)
(610) 375-3277 (f)